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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,310	08/06/2003	Jack Richard Warner	5853-244	8146

7590 02/10/2005
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EXAMINER

PAK, JOHN D

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,310

Applicant(s)

WARNER ET AL.

Examiner

JOHN PAK

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Claims 1-32 are pending in this application.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7 and 14-19, drawn to an insect bait composition comprising (a) a plurality of amino acids, (b) sugar, and optionally, (c) preservative, classified in class 426, subclass 1, as well as numerous food art subclasses due to the claims reading on basic food items such as preserved meats or seafood with sugar flavoring.
- II. Claims 8-13, 20-25, 27, drawn to an insect killer/bait method and composition comprising a toxicant in addition to (a) a plurality of amino acids, (b) sugar, and optionally, (c) preservative, classified in multiple subclasses in classes 424 and 514 depending on the chemical structure of the toxicant, such as for example, class 424, subclass 660 (octaborate), class 514, subclass 229.2 (thiamethoxam)
- III. Claim 26, drawn to a method for controlling insects comprising providing an insect bait comprising a plurality of amino acids, a sugar and a preservative, and applying the bait to an area to be controlled, classified in class 424, subclass 84.
- IV. Claim 28, drawn to a method for controlling insects comprising steps such as sampling nectars and honeydews and determining their compositions, formulating a mimic from said compositions, combining with a toxicant and

applying the mixture to a location, classified in numerous subclasses in classes 424 and 514 depending on the chemical or structural nature of the toxicant and bait.

- V. Claims 29-32, drawn to a method of preparing a granular insect bait, the method comprising the steps of mixing a lipid containing substance and an insect bait comprising a plurality of amino acids, sugar and preservative with a granular carrier and heating the carrier until the carrier retains about 8-13% moisture, classified in class 424, subclasses 489+.

If applicant elects an invention group that uses a toxicant, a further election of a single disclosed species of the toxicant such as disodium octaborate tetrahydrate or thiamethoxam is required.

Inventions of Group I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as in the feeding of mammals for nutrition.

The three method inventions, Groups III, IV and V are independent or distinct. They are not related to one another. Group I, II and III are distinct over one another

because the combination of ingredients represented by Group I or II is readable on all types of food items that may have nothing to do with insect control, whereas the presence of an insect toxicant in Group II renders it distinct.

Further, a search for more than one invention group would place an undue burden on the Examiner. The search for the various invention groups require divergent search fields and divergent search classes and subclasses. The search and examination burden is already quite demanding due to the broad scope of the food type bait material (claim 1 reads on Chinese food) and an unlimited scope of the insect toxicant component. Plus, the method invention of Group IV is so divergent from the rest of the inventions as to require a completely different search with virtually no overlap in search results.

Therefore, for reasons of distinctness and undue burden, the restriction requirement as set forth above is deemed to be proper.

A telephone call was made to Mr. Theodore Green on 11/9/2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Gary Kunz, can be reached on **(571)272-0887**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'John Pak', with a stylized, cursive script.

JOHN PAK
PRIMARY EXAMINER
GROUP 1/600